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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,232	10/03/2003	Knut H. Henriksen	D5407-214	3539

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EXAMINER

NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,232

Applicant(s)

HENRIKSEN ET AL.

Examiner

William P Neuder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11, 15 and 20 is/are rejected.
- 7) ☒ Claim(s) 4-6, 12-14 and 16-19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/3/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 states "using a valve member in said valve assembly made of on of rubber, elastomer, clay, EPDM and Halobutyl". This is not understood. Clarification is required.

Claim Objections

Claim 1 is objected to because of the following informalities: In line 4, no antecedent basis could be found for "the fluid" and the term "it" is not acceptable. The claim language must be complete and definite. The structure the term "it" represents must be used in place of "it". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,7,8,15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Towers et al 6,367,547.

Towers discloses a valve assembly 204 for downhole use. The valve has a body and a passage 207 there through. Float valve is selectively operable between open and closed positions based on the composition of the fluid contacting the float. The density of crude will cause the valve to close. As to claims 7 and 8, the valve closes in response to crude that contains hydrocarbons and does not close if the fluid does not contain hydrocarbons. As to claim 15, the method comprises flowing fluid from the well through the valve to the surface. Closing the valve in response to crude that causes the flow to be changed or redirected. As to claim 20, the valve can be an elastomer.

Claims 1,2 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Gil et al 5,148,825.

Gil discloses a valve assembly 10 for use in a hole. The term for downhole use is intended use. However, since the valve assembly 10 is in a hole, this is considered downhole. The valve controls flow through inlet 6 to outlet 8. The valve member is closed and opened in response to the moisture content in the valve assembly section 124. As to claim 2, section 124 swells causing the flow passage to restrict and eventually close if the moisture content is high enough. As to claim 9, the valve member is responsive to water. As to claims 10 and 11, the valve member can be formed from an elastomer. An elastomer is considered to be rubber.

Claims 1-3 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Heaven 5,722,931.

Heaven discloses a valve assembly 22. The term for use downhole is intended use and the valve assembly of Heaven could be used downhole. A flow passage is provided in

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the valve body. Means 20 is selectively operable between an open and a closed position based on the composition of the fluid contacting member 20. The member 20 increases in volume when contacted by urine. As to claim 3, the member 20 forms a gel when contacted with the fluid. This is seen to be hardened. As to claim 9, the urine is considered water. As to claims 10 and 11, the member 20 can be formed from elastomers or rubber.

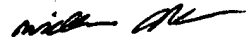
Allowable Subject Matter

Claims 4-6,12-14 and 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William P Neuder
Primary Examiner
Art Unit 3672

W.P.N.